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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,558	01/18/2001	Vincent P. Annunziata	03169- P0003B	6841

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EXAMINER

TINKLER, MURIEL S

ART UNIT	PAPER NUMBER
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3691

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/764,558	Applicant(s) ANNUNZIATA, VINCENT P.	
	Examiner MURIEL TINKLER	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 21 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application has been reviewed. Claims 1-25 are pending. The rejection(s) are as follows.

Response to Arguments

1. Applicant's arguments filed March 21, 2008 have been fully considered but they are not persuasive. The Applicant argues: there is no motivation to combine the references; the Office Action cites prior art that was disclosed in the Bettis reference and is also concerned with the number of references used; and, Bettis does not disclose the 'a winner' and neither does the Davis reference. The Examiner disagrees.
2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both the Bettis and Davis references are concerned with gaming transactions over a communications network. The fact that Davis uses satellite communications or neural networks for processing does not deter from the fact that the networks are used for similar purposes.
3. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection

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does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Furthermore, the fact that the Bettis reference lists the information the Examiner cites as being 'prior art' only adds to the fact that the information is old and well known in the art. Finally, the fact that the Examiner cites information pertaining to older references taken the Bettis reference, does not negate the fact that the information **WAS** in fact taken from the Bettis references.

4. In response to the Applicant's arguments that Davis does not disclose the use of 'a winner', the Examiner disagrees. As stated in the Applicant's Arguments on page 10, Davis discloses the act of determining a winner in column 24 (lines 36-38). Reaching a conclusion to determine a winner [based on some criteria] is what Davis describes.

Double Patenting

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 44 of copending Application No. 09/764,574. This is a

provisional double patenting rejection since the conflicting claims have not in fact been patented.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

8. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claim 1 is also provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 12/070,138. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims identify overlapping subject matter, however this claim does add the concept of game-ending criteria. However, it could be deemed obvious that if there is a game, there must be some form or method to end the game. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-17 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bettis et al. (US 7,016,872) in view of Davis et al. (US 6,030,288), hereafter referred to as Bettis and Davis respectively.

12. Regarding claims 1 and 12, Bettis discloses:

a. Commodities trading in column 15 (lines 41-67)

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- b. A computer network in column 2 (lines 50-67) and column 13 (lines 38-45)
 - c. Database for storing player files and indication(s) submitted by players in column 1 (lines 57-64) and column 4 (lines 32-44)
 - d. A player score in the Abstract
 - e. An indication selected by a player in column 2 (lines 33-49)
 - f. Software for selecting and receiving indications from a player in column 2 (lines 33-49)
 - g. Retrieving game ending criteria, ceasing game play and retrieving scoring criteria in the Abstract
 - h. Retrieving player portfolio in column 2 (lines 22-32)
 - i. Comparing and ranking players (top ranked player can be inferred as 'winner') in the Abstract
13. Bettis does not specifically disclose a winner in a game. Davis discloses a winner in paragraph 234 and the end of a game in paragraph 104. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Bettis to include a 'winner' at the end of the game because it would clearly define when a game has ended and who is determined to have completed the game with the best ranking. Also, the use of a game simulation allows users to practice and become familiar with a topic before they are to perform.
14. Regarding claim 2, Bettis does not disclose the use of a database for controlling the game flow. Davis teaches the use of a database that contains rules for controlling game flow in the Abstract. See also the rejection of claim 1 above. Therefore, it would

have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Bettis to include a database for controlling game flow because it stores the information necessary to performing the gaming functions.

15. Regarding claim 3, Bettis discloses the valuation of the current portfolio and stocks pricing in column 2 (lines 22-32).

16. Regarding claim 4, Bettis discloses an expiring time period in column 5 (lines 28-48).

17. Regarding claims 5 and 7, Bettis does not disclose rules for game ending criteria. Davis teaches rules for game ending criteria based on predetermined game rules in figure 18. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Bettis to include rules for game ending criteria because it provides clear rules for the ending of the simulation.

18. Regarding claim 6, Bettis discloses generating a portfolio in column 2 (lines 9-21).

19. Regarding claim 8, Bettis discloses players beginning the game with predetermined commodities in column 2 (lines 22-32).

20. Regarding claims 9 and 10, Bettis discloses a submission form containing a proposed bid/offer in figure 5; and, updating scores in column 4 (lines 54-67).

21. Regarding claim 11, Bettis does not disclose software for retrieving game rules and determining a violation. Davis teaches software that retrieves game rules and determines a violation in column 25 (lines 15-31).

22. Regarding claims 13 and 21, Bettis does not disclose the use of selecting formatting. Davis teaches the use of custom formatting in Table 5, column 20(line 35) through column 21 (line 55) and column 21 (lines 63-67).
23. Regarding claim 14, Bettis discloses the act of sorting in column 5 (lines 28-48).
24. Regarding claim 15, Bettis discloses selecting content in column 2 (lines 22-32).
25. Regarding claim 16, Bettis does not disclose a request to register or a completed registration form. Davis teaches a request to register in column 7 (lines 24-30) and completing a registration form in column 7 (line 66) through column 8 (line 26).
26. Regarding claim 17, Bettis discloses the use of the Internet in figure 20.
27. Regarding claims 22 and 23, Bettis discloses a tabular format for reviewing current bids/offers in figure 5. Bettis does not disclose the act of viewing indications at real time. Davis teaches the act of viewing indications at real-time in column 15 (lines 1-12). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Bettis to include the act of viewing indications at real time so that the players have the most up to date information when placing bids.
28. Regarding claim 24, see the rejection(s) of claims 1, 9 and 10 above.
29. Claims 19-20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bettis and Davis as applied to claims 1 and 2 above, and further in view of Sernet (US 2002/0032632), hereafter referred to as Sernet.
30. Regarding claims 18-20, Bettis and Davis do not disclose criteria for and types of gaming rules. Sernet teaches user defined limits (pre-defined game limits/rules) in

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paragraph 28. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Bettis and Davis to include gaming limits because it provides a clear set of constraints for users to follow.

31. Regarding claim 26, see the rejection(s) of claims 1, 6 and 18-20 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MURIEL TINKLER whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 6:30 AM until 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. T./
Examiner, Art Unit 3691

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691